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Supreme Court of the United States

OCTOBER TERM, 1951

No. 144

JOHN G. KURZEN, JR.

Petitioner

v.

JOHN A. MARZALL, Commissioner of Patents

Petition for Writ of Certiorari to the United States Court of Appeals for the District of Columbia

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SOL SHAPPIRIO
HAYDEN C. COVINGTON
Counsel for Petitioner

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MAY IT PLEASE THE COURT:

Petitioner prays that a writ of certiorari issue to review the judgment entered in this case on March 29, 1951 by the United States Court of Appeals for the District of Columbia. [55][1]

Opinion Below

The district court wrote a brief opinion. [8] The opinion of the court of appeals appears in the record. [54] It is not yet reported.

Jurisdiction

The judgment of the court of appeals was entered on March 29, 1951. [55] The jurisdiction of this Court is in-

[1] Figures in brackets refer to pages of the printed record.

voked under Chapter 646 of the Act of June 25, 1948; 62 Stat. 928, 28 U. S. C. 1254.

Questions Presented

ONE

Is the petitioner entitled to a design patent on a portable phonograph which presents a departure from all prior designs, the appearance of which attracts attention in a new and ornamental manner promoting progress and science and useful arts within the meaning of Section 8, Article I of the United States Constitution and the laws of Congress?

TWO

May the patent office and the courts below disintegrate prior patents and from them mentally reconstruct a new device so as to anticipate petitioner's design and deny him his rights under Section 8, Article I of the United States Constitution and the laws of Congress?

Statute Involved

The courts below were called upon to construe and apply Sections 4929 and 4933 of the Revised Statutes as amended, being 35 U. S. C. 73. It reads as follows:

"§73. Patents for designs; how obtained; regulations applicable

"Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the

same as in cases of inventions or discoveries covered by section 31 of this title, obtain a patent therefor.

"All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this title, shall apply to patents for designs."

Statement

Petitioner duly filed in the time and manner required by law an application for patent. It appears in the patent office files. It was received into evidence. [37-51] The original exhibits have been sent up to this Court. [10]

The application covered a diminutive, shoulder-strap, portable phonograph, the size of a lady's purse, which was demonstrated to the trial court by witnesses who testified for the petitioner. The object covered by the design under application D-120,153 was described as square, thin, being one-fourth as thick as it is high and wide, having two grilles for the emission of sound. The design was said to describe "a midget phonograph. It is not a big one like the usual horizontal type." [11] The design shows an upright, portable phonograph different from all other phonographs, being midget in size and operating in vertical position. [11] The design is different from the usually broad portable phonographs that operate in a horizontal position. [11] The design shows the midget, vertical phonograph suspended from the shoulder by a strap similar to that of a lady's shoulder purse or bag. [12]

The witness showed that the Motorola automobile radio relied on by the Patent Office had no similarity, it being a housing box for the electrical equipment of the automobile radio. The witness showed that no similarity existed between the Motorola box and the portable phonograph. [13-14] The witness showed that there was no similarity between the grillwork in the small vertical phonograph and the grillwork of the huge General Electric transmitter relied

on by the Patent Office. [14-15] The witness showed that the design described a small phonograph easily adaptable to carrying on the person like a woman's purse. [15] The witness showed that there was no portable phonograph that had a similar appearance to that shown in the design. [15-16] The witness explained that there would be considerable difficulty experienced if the rounded curves and the grillwork of the various devices referred to by the Patent Office were substituted for that of the design in question. [17-19]

A radio engineer showed that petitioner's design had no similarity to that of the five references made by the Patent Office in the denial of the Kurzen application. [21-29] It was shown that there was no similarity between the Philco radio-phonograph and the Kurzen design. [22] The grillwork of the Philco design "is to my mind much different and doesn't resemble the opening". [22] "The two openings on the Kurzen device have more of a rectangular effect although there is no straight line involved where the Philco has the effect of the appearance of an oval". [23] The Motorola device was distinguished in appearance by the witness from the Kurzen design. "It would be stretching the imagination to say that we would look at the Motorola and then go and design another case with different radiuses and say anyone that would come along and say that it resembles it or that we copied from it." [23-24] The Harrison Wholesale Co. device was distinguished and shown to have no similarity. [24-25] The General Electric transmitter design relied on by the patent office was shown to be clearly dissimilar to the Kurzen design. "The resemblance between the General Electric transmitter and the Kurzen device is not apparent at all because here we have, again, a louvre effect with many lines on it, and the lines themselves run all the way across the louvre, with the appearance of a rectangular opening with square corners in the opening. If a design patent was given on this General Electric trans-

mitter it would not be because of the presence or absence of those louvres but on the general appearance to the eye, and which in this case is much different than the Kurzen device." [26]

Concerning all of the references made by the Patent Office in the denial of the Kurzen application it was said, "I don't see how anyone could mistake the Kurzen device for any of these, or even the combined effect of all of them put together." [26] Petitioner was shown to have produced a device that gives a new impression to the eye when considering it as a whole from all other devices known to the electrical and sound-reproducing field. [26-28]

Following the denial of the application for patent, an action was instituted by petitioner in the district court under 35 U. S. C. 63, no appeal being filed in the United States Court of Customs and Patent Appeals. [2-3]

The respondent answered admitting the jurisdiction of the court to entertain the action. [3-4] The action was brought to obtain a patent on a design for a portable phonograph. [2-3] The district court heard evidence and dismissed the civil action at the cost of petitioner. [5-6] The court found that the design covered by the application for patent did not involve "anything which in the eye of the ordinary observer would produce a different effect from anything that has preceded it". [8] He found that the references cited by the Patent Office disclosed that the design had been anticipated by the prior art. [8] He concluded that the design "manifests nothing in the nature of invention". [8] The court found that petitioner filed his application for design patent No. 120,153 on the portable phonograph. He described the design for the portable phonograph cabinet as "comprising a box, essentially square in conformation but having a thickness substantially less than the other dimensions. The casing is provided with rounded corners, two side-by-side grilles near the top of one of the larger faces, and a handle folded into one of the edges." [6]

The court found that the large portable radio cabinet of the Harrison Wholesale Co. cited by the Patent Office had "a substantially square outline and a thickness less than its other dimensions. It is provided with slightly rounded corners and a pair of side-by-side grilles on the upper part of one of the cabinet faces." [6] The court found that the Philco portable phonograph cabinet was "provided with a grille having a rounded outline and three cross bars formed of the material of the cabinet." [6] The court found that the Motorola automobile radio "comprises a box of rectangular outline and reduced thickness with rounded corners." [7] The court found that the British portable phonograph cabinet had "a handle m adapted to fold into the side of the cabinet about hinge m'". [7] The court found that by combining the above cited citations in the different objects covered by the prior art the design of petitioner was anticipated and did not involve invention. [7] The court concluded that separate references from different objects may be combined in rejecting a claim for a design patent and that a new and utilitarian function did not contribute to the patentability of petitioner's design. [7-8]

The petitioner duly appealed to the court of appeals. [8-9] The court of appeals held:

"The application involved in this proceeding discloses a design for a phonograph cabinet comprising a box, essentially square in conformation but having a thickness substantially less than other dimensions. The casing is provided with rounded corners, two side-by-side grills near the top of one of the larger faces, and a handle folded into one of the edges. Each one of these features is contained in a prior patent.

"We feel the lower court was quite correct when it held that 'A number of references may be used to rejecting a claim to a design if each of the features is old and no invention is involved in combining them.' Therefore, the judgment of the District Court is *Affirmed.*"

Specification of Errors

The Court of Appeals erred:

(1) in deciding that the design invention of the portable phonograph did not involve such inventive talent as the statute required.

(2) in considering as prior art certain earlier patents embodying unintegrated elements of petitioner's design.

(3) in concluding that petitioner's patent was invalid for lack of invention.

(4) in finding anticipation by picking out parts of other totally different devices of other classes of design and mentally integrating and reconstructing them into a design like that described in petitioner's application for patent.

Reasons for Granting the Writ

The decision of the court of appeals strikes dead the spirit and perverts the intention of Congress expressed in Section 73 of Title 35 of the United States Code. It has allowed the patent office to reach into fields outside the limited class relating to a particular design, cull from here and there portions of other designs and reconstruct them by a "scissors and paste-pot" method to justify the denial of a meritorious application for design patent.

The court of appeals has announced a doctrine which authorizes the patent office to water down and completely emasculate Section 73, Title 35 of the United States Code.

It is for Congress to repeal the design patent statute rather than allow the patent office to drain the blood out of the body of the statute and produce its slow but certain demise. The design patent statute is dead, having been unlawfully given the *coup de grace* by the patent office with the imprimatur of the courts below.

I

The decision of the court below is in conflict with the holdings of other courts of appeals. *Naylor et al.* v. *Alsop Process Co.*, 168 F. 911, 920 (C. A. 8); *Wisconsin-Minnesota Gas & Electric Household Appliance Co.* v. *Hirschy Co.*, 28 F. 2d 838, 841 (C. A. 8); *J. A. Mohr & Son* v. *Alliance Securities Co.*, 14 F. 2d 799, 800 (C. A. 9); *Mygatt et al.* v. *Schaffer*, 210 F. 827, 830-831 (C. A. 2).

II

The decision of the court below is in conflict with the holdings of this Court in *Gorham Mfg. Co.* v. *White*, 14 Wall. 511, 525; *Knapp et al.* v. *Morss*, 150 U. S. 221, 228; *Miller, et al.* v. *Eagle Mfg. Co.*, 151 U. S. 186, 203.

III

An important question is involved that has been decided by the court of appeals, which ought to be decided by this Court, affecting the interests of the public and the design patent law. This case presents exceptional circumstances that are sufficient to constrain this Court to grant the petition for writ of certiorari. It is important for the people to be definitely and finally told whether the design patent law is dead or alive.

Discussion

Until the aberration of the court below it has been the patent law of the land that design patents could not be refused by the use of a pair of scissors and a paste pot to reproduce from other designs an imaginary design which anticipates a new and inventive real design.

Thus, in *Mygatt, et al.* v. *Schaffer*, 210 F. 827, the Court of Appeals for the Second Circuit said:

"In *Washbourne & Dunn* v. *Webster*, 195 Fed 522, 115 C. C. A. 432 (1912), each element of the patented design considered separately was old, and sometimes two or more of

them appeared combined in the prior art, and yet we held that these facts did not invalidate the patents, unless it appeared that they were so assembled as to form the designs of the patents then in suit. And we then stated that it was the design as a whole which had to be considered; that the situation in this respect was analogous to machines made up of old elements. It sufficed that the machine produced a new result, or the design a new impression upon the eye. It is the design of the whole thing that it appears in use which is the test in cases of the class in suit." 210 F. at pp. 830-831.

Also a combination of references into a new imaginary device was rejected in *Naylor et al.* v. *Alsop Process Co.*, 168 F. 911. The Court of Appeals of the Eighth Circuit said: "When it is sought to ascertain the state of the art by means of prior patents, nothing can be used except what is disclosed on the fact of those patents. Such patents cannot be re-constructed in the light of the invention in suit, and then be used as a part of the prior art." (168 F. at p. 920) Similarly, in *J. A. Mohr & Son* v. *Alliance Securities Co.*, 14 F. 2d 799, 800, the Court of Appeals for the Ninth Circuit states the same doctrine.

In *Wisconsin-Minnesota Gas & Electric Household Appliance Co.* v. *Hirschy Co.*, 28 F. 2d 838, 841, the Court of Appeals for the Eighth Circuit stated: "This practice of building up anticipation by changing and combining parts of structures of prior patents cannot be indulged."

Petitioner's new and ornamental design for a portable phonograph presents a departure from all prior designs. It is small. The case stands vertical. It is of equal width and height. The corners are well rounded with a large raduis. It is "thin", that is its depth or thickness (from front to rear) is one-fourth of its height. On its front face, are two identical matched grilles, adjacent each other, both above the center line of the face, in balanced relation. The contour of each grille simulates the contour of the case. Each grille

is of equal width and height. The corners are well rounded with a large radius. The louvres relieve the impression of the grilles. The handle lies closely contiguous the case, in unobtrusive fashion.

The artist has thus produced a design for a phonograph that is as elegant as it is simple, as unique as it is novel.

A patent for this design has been refused on a so-called combination of cited catalogue pages from different manufacturers and a British patent. Mere inspection shows that not a single one of the citations is suggestive of appellent's design, not even remotely so. So, to synthesize a rejection, isolated elements have been taken at will here and there from the unrelated flat phonographs, vertical radios, and at times even gigantic radio-frequency transmitters, and these unrelated, isolated elements have been synthesized into an imaginary structure, impossible to visualize, as a basis for a refusal of a patent.

Petitioner under the law is entitled to a patent where the Patent Office seeks to build up a hypothetical structure from a number of citations, not a single one of which gives the visual impression on the casual observer that results from appellant's design.

While petitioner's application for a design patent was in course of consideration by the Patent Office, a change in established standards for design patents was made by a new office head. The new policy was that design patent protection should not apply to more common articles of manufacture. Such extreme views, found incongruous, have recently been relaxed by later office management. But before the illegal policy was corrected the petitioner has been refused his patent. The discriminatory result to petitioner by the reversal of the Patent Office policy leads us to the necessity of seeking a remedy in this Court.

It is of interest relative to the present case that the temporary departure from the long-practiced standards in the Patent Office has been relaxed, but too late to help pe-

titioner; and note may be made of some random simple designs for common articles of utilitarian manufacture recently issued:

Suitcase or Satchel No. D-159,128
Television Cabinet No. D-159,161
Automobile Bumper No. D-159,230
Cutting Shears No. D-159,231
Carpenter's Plane No. D-159,339

The discrimination inadvertently worked on petitioner during the period of repeal is manifest, and in equity calls for correction by this Court.

The design in question gives a distinctive appearance to the new midget portable phonograph. It enhances its appearance and attracts attention to the design of a new thing in the field of portable phonographs.

The purpose of Revised Statute 4929 is to provide a patent for a new and ornamental design for articles of manufacture not used or made before. The law encourages new design of articles of manufacture. The Design-patent Law covers ordinary articles of manufacture. The law is distinguished from the Copyright Law which protects the fine arts. The law should be liberally construed and design patents should be looked upon with greater leniency than other patents because the design patent is limited and does not occupy a great zone in the field.

While the Copyright Law operates in the domain of the fine arts, the Design-patent Law provides for the more lowly field of designs for articles of manufacture. As stated by the Supreme Court in the leading case *Gorham Mfg. Co.* v. *White,* 14 Wall. (81 U. S.) 511, 525,

> "And the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture or article to which it may be applied or to which it gives form. The law manifestly contemplates that giving certain new

> and original appearances to a patented article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. . . . It is the appearance itself which attracts attention and calls out favor or dislike. . . . The appearance may be the result of peculiarity of configuration, or of ornament alone, or both conjointly, but in whatever way produced, it is the new thing or product which the law regards."

The purpose of the law is to encourage the patenting of new designs for articles of manufacture. Revised Stat. 4929 provides:

> "Any person who has invented any new, original, and ornamental design *for an article of manufacture,* not known or used by others in this country before his invention thereof, . . . may . . . obtain a patent therefor," R. S. 4929 (Italics added).

In contradiction from works of the fine arts, which are provided for in the Copyright Law, the Design-patent Law deals with ordinary articles of manufacture. As was pointed out by the court in *Dominick and Haff* v. *R. Wallace & Sons Mfg. Co.,* 209 F. 223, 224 (C. A. 2);

> "A design patent necessarily must relate to subject matter comparatively trivial and the courts have looked with greater leniency upon design patents than for other inventions."

In *Rousso* v. *Boyle,* 2 F. 2d 299, 300, it was stated: (D. C. Minn.)

> "It may be said that all this is very simple. This does not exclude invention, nor the patentability of the design. In this connection all that can or need be said is that throughout a long line of decisions, beginning with *Gorham* v. *White,* 14 Wall. 511, 20 L. Ed. 731, de-

sign patents covering designs quite as simple as this have been upheld."

Whether there is an anticipation of the design of the petitioner is to be determined by its appearance to the eye of the ordinary observer. The design as a whole must be considered. As long as it involves invention it is patentable.

Previously patented designs relied upon by the Patent Office must be limited to only what they teach. The various and different design patents referred to by the Patent Office may not be recombined, reconstructed and redesigned mentally to destroy petitioner's design. The Patent Office is not permitted to pick out elements from various structures and arbitrarily make up a new combination imaginary design to anticipate petitioner's design.

Conclusion

The application and claims presented by the petitioner to the patent office show the novel, useful invention of a design which was not anticipated by prior art. The design should have been patented. Petitioner has no recourse under the Copyright Law or any other law save and except under Section 73 of Title 35 of the United States Code. He should not be pushed beyond the reach of the protection Congress intended to give him in the absence of a repeal of the statute by Congress.

For the reasons stated herein, this petition for writ of certiorari should be granted.

Respectfully submitted,

HAYDEN C. COVINGTON
SOL SHAPPIRIO
Counsel for Petitioner

June, 1951.